

### **REMARKS**

The present application includes claims 1-8 and 41. The Office Action rejected claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,235,038 to Hunter *et al.* ("Hunter"). Claims 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter in view of U.S. Pat. No. 6,827,723 to Carson ("Carson"). Claim 41 was allowed. The Applicant respectfully traverses the outstanding rejections for the reasons set forth hereafter.

#### **35 U.S.C. § 102(b) Rejections**

Claims 1-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hunter. The Applicant respectfully traverses these rejections.

"A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The **identical** invention must be shown in as complete detail as is contained in ... the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Hunter relates to a system for utilizing and registering at least two surgical navigation systems during stereotactic surgery. The system comprises a first surgical navigation system defining a first patient space, a second surgical navigation system defining a second patient space, and a translation device to register the coordinates of the first patient space to the coordinates of the second patient space. The translation device comprises a rigid body, at least

one component for a first navigation system placed in or on the rigid body, and at least one component for a second navigation system placed in or on the rigid body, in known relation to the at least one component for the first navigation system. The translation device is positioned in a working volume of each of the at least two navigation systems. Hunter at Abstract.

The Applicant respectfully submits that Hunter does not teach or suggest all of the limitations of claim 1, and, therefore, claims 1-5 are not anticipated by Hunter. Hunter does not teach or suggest that “said second localizing device at said first fixator is detached from said first fixator and attached to said instrument and said first localizing device at said second fixator is detached from said second fixator and attached to said first fixator” as recited in claim 1. While Hunter may disclose that “optical elements 20, 70 may be placed on the patient or on the medical instrument 60 for tracking movement of the patient 30 and/or the medical instrument 60 during the procedure,” *see* Hunter at 5:53-56, Hunter does not teach or suggest a system where one of the optical elements at a first fixator is detached from the first fixator and attached to an instrument and that another optical element at a second fixator is detached from the second fixator and attached to the first fixator from which the first optical element was detached. Indeed, Hunter makes no mention of moving an optical element to another fixator or device after being placed on a medical instrument or patient or having another optical element take its place on the medical instrument or patient. As such, Applicant respectfully submits that Hunter does not teach all of the limitations of the system recited in claim 1, and therefore does not anticipate claims 1-5.

**35 U.S.C. § 103(a) Rejections**

**Claims 6-8**

Claims 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter in view of Carson. The Applicant respectfully traverses these rejections.

In order for a *prima facie* case of obviousness to be established, the MPEP states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Federal Circuit has stated that “rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some articulated reasoning with **some rational underpinning** to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)).

Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

“To establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03 (emphasis added). Further, “[a]ll words in a claim **must** be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.* (emphasis added).

Carson relates to systems and processes for tracking anatomy, instrumentation, trial implants, implants, and references, and rendering images and data related to them in connection with surgical operations, for example unicompartmental knee arthroplasties. These systems and processes use a computer to intra-operatively obtain images of body parts and to register, navigate, and track surgical instruments. Carson at Abstract.

The combination of Hunter and Carson does not teach or suggest all of the limitations of claims 6-8, and therefore claims 6-8 are not obvious over Hunter in view of Carson. As discussed above with respect to claim 1, Hunter does not teach or suggest that “said second localizing device at said first fixator is detached from said first fixator and attached to said instrument and said first localizing device at said second fixator is detached from said second fixator and attached to said first fixator,” as recited in claim 1. Likewise, Carson does not teach or suggest these limitations. Therefore, claims 6-8, which depend from claim 1, are not unpatentable over Hunter in view of Carson.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicant will not

address such statements at the present time. The Applicant expressly reserves the right, however, to challenge such statements in the future should the need arise (*e.g.*, if such statement should become relevant by appearing in a rejection of any current or future claim).

If the Examiner has any questions or if the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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Date: June 29, 2010

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